



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/659,046	06/03/96	BAUER	P 07807/006001

JOHN B. PEGRAM
FISH & RICHARDSON P.C.
45 ROCKEFELLER P.C.
NEW YORK NY 10111

QM21/1210

EXAMINER

DEXTER, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 12/10/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/659,046

Applicant(s)
Bauer et al.

Examiner
Clark F. Dexter

Group Art Unit
3724



☒ Responsive to communication(s) filed on Oct 13, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 6-8 and 13-16 is/are pending in the application.

Of the above, claim(s) 13 and 14 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 6-8, 15, and 16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/508,255.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3724

DETAILED ACTION

1. The amendment filed October 13, 1998 has been entered.

Claim Rejections - 35 USC § 112

2. Claims 6-8, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, line 13, "said rotating axis" lacks positive antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 6, 8 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Shearer.

Shearer discloses a cutting tool which meets every structural limitation of the claimed invention (in the same manner as the invention shown in Figure 3 of the present invention which also shows forceps), wherein the cutting tool includes a cutting element and a handle attached thereto. It is noted that using two of these cutting tools to form the claimed hand-held tool,

Art Unit: 3724

whereby the sides having the cutting edges are held so that they are directly touching each other, is considered a functional recitation of the intended use of the cutting tool (i.e., it is considered an intended use of the forceps of Shearer). Similarly, the relative orientation of the tool to the workpiece, including the relative orientation of the tool to a plane defined by the workpiece and an axis about which the tool is rotated (e.g., the limitation "about an axis to apply a torsional shearing force on the body in a plane transverse to the longitudinal axis of the body, whereby said rotating axis cuts the plane extending between said cutting edges of said shearing elements"), is considered to be describing an intended use of the claimed invention and has been given little patentable weight.

5. Claims 6-8, 15 and 16, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by British Patent 20,244 (GB '244).

GB '244 discloses a cutting tool in Figures 1-5 with every structural limitation of the claimed invention (in the same manner as the inventions shown in Figures 2 and 3 of the present invention which show independent tools) including a disc (e.g., E,K,I) having a slot (e.g., formed by K and I) forming a cutting edge at one side of the disc (e.g., the right side as viewed in Figure 2), and a handle (e.g., A,C) connected to the disc. It is noted that using two of these cutting tools to form the claimed hand-held tool, whereby the sides having the cutting edges are held so that they are directly touching each other, is considered a functional recitation of the intended use of the cutting tool (i.e., it is considered an intended use of the cutter of GB '244). Similarly, the relative orientation of the tool to the workpiece, including the relative orientation of

Art Unit: 3724

the tool to a plane defined by the workpiece and an axis about which the tool is rotated (e.g., the limitation "about an axis to apply a torsional shearing force on the body in a plane transverse to the longitudinal axis of the body, whereby said rotating axis cuts the plane extending between said cutting edges of said shearing elements"), is considered to be describing an intended use of the claimed invention and has been given little patentable weight.

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stolpe.

Stolpe discloses a cutting apparatus (e.g. in Figure 2) with every structural limitation of the claimed invention including an upper shearing element (connected to e'), a lower element (connected to f'), and a means (e.g. b, l', l'') for rotating the elements counter to one another.

Art Unit: 3724

In the alternative, if it is argued that Stolpe does not include handles which are to be grasped by hand, it is the Examiner's position that the threaded/linkage mechanism (e.g., p,q,r,s,t) of Stolpe is provided to obtain a mechanical advantage to facilitate rotation of the arms/handles (e.g., g,o). It is known to those skilled in the art that mechanisms used to gain mechanical advantage have there cost. One "cost" is reduced speed of operation. Therefore, it would have been obvious to one having ordinary skill in the art, when using the device of Stolpe to cut softer material (e.g., soft iron or iron products) to remove the linkage from the arms/handles of Stolpe so that they can be pivoted more quickly and improve manufacturing efficiency (i.e., to cut workpieces more quickly).

Claim Rejections - 35 USC § 103

8. Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Stolpe in view of Schweitzer.

Stolpe discloses a cutting apparatus (e.g. in Figure 2) which discloses or suggests almost every structural limitation of the claimed invention including a handle (e',f') attached respectively to each shearing element but lacks each shearing element comprising a disc having a slot with a cutting edge extending from the outer periphery toward the center. Schweitzer discloses a cutting apparatus wherein the shearing elements each include a disc having a slot with a cutting edge as claimed wherein the slot narrows towards the center, and teaches that peripheral slots are provided for inserting lengths of rebar therein for cutting the rebar. Therefore, it would have been

Art Unit: 3724

obvious to one having ordinary skill in the art to provide the discs of Schweitzer with slots therein on the cutting apparatus of Stolpe to gain the benefits taught by Schweitzer including that described above.

Response to Arguments

9. Applicant's arguments filed October 13, 1998 have been fully considered but they are not persuasive.

In the third paragraph on page 3 of the amendment, applicant argues that the claim has been further amended to distinguish the claims from the prior art. The Examiner respectfully disagrees, particularly with respect to the rejections over Shearer and British Patent 20,244 (GB '244). No structure has been added to the claims. The only limitation added to claim 6, specifically the limitation "whereby said rotating axis cuts the plane extending between said cutting edges of said shearing elements," is directed to how each tool is oriented with respect to the workpiece. The "rotating axis" refers to an axis about which each tool is rotated. However, each tool is independent from the other, and thus to orient these tools such that they rotate about a particular axis is clearly an intended use of each tool. Similarly, "the plane" refers to "a plane transverse to the longitudinal axis of the body" which is clearly an intended use describing how each tool is used to cut the workpiece (i.e., the body). It is well settled patent law that a recitation of the intended use cannot patentably distinguish the claimed invention from the prior art, and thus the added limitation does not distinguish the present invention over the prior art.

Art Unit: 3724

Regarding applicant's arguments in the last paragraph on page 3, all of page 4, and in the first three paragraphs on page 5, the same arguments that were made hereinabove apply thereto.

In the last paragraph on page 5 of the amendment, and on pages 6-10, applicant argues against the rejection under 35 USC 102/103 over Stolpe, and against the rejection under 35 USC 103 over Stolpe in view of Schweitzer. It is respectfully submitted that the Examiner's position remains the same as that of the previous Office action (paper #14). Specifically, the Examiner stated that:

applicant argues that the device of Stolpe is not a hand-held tool and that this limitation in the preamble is structural. The Examiner respectfully disagrees and maintains the position that there is no structure in the body of the claim to structurally distinguish the invention over Stolpe. Further, it is noted that the actual size of the device of Stolpe is not known, however, it is well settled case law that a change in size is generally recognized as being within the level of ordinary skill in the art. The size of Stolpe could very well be a size wherein it can be hand-carried, or hand-held.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 3724

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

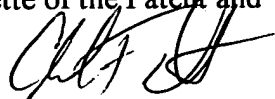
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfid
December 8, 1998